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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,502	09/19/2003	James L. Chappuis	050313-1110	8958
24504	7590	08/22/2005	EXAMINER	
THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP 100 GALLERIA PARKWAY, NW STE 1750 ATLANTA, GA 30339-5948			SMITH, FANGEMONIQUE A	
			ART UNIT	PAPER NUMBER
			3736	

DATE MAILED: 08/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

TJL

<b>Office Action Summary</b>	<b>Application No.</b> 10/666,502	<b>Applicant(s)</b> CHAPPUIS, JAMES L.	
	<b>Examiner</b> Fangemonique Smith	<b>Art Unit</b> 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/19/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>06/23/04</u> . | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities:
  - a. At line 13 of page 1, the word -- an -- should be inserted before “interdiscal tensiometer apparatus” to indicate only one apparatus is disclosed in the application.
  - b. At line 14 of page 1, the word “methods” should be replaced by the word -- method -- to indicate only one method of use disclosed in the application.
  - c. At line 18 of page 2, it is suggested to change “to achieving” to read -- to achieve -- to maintain appropriate tense.Appropriate correction is required.

### *Claim Objections*

2. Claim 2 is objected to because of the following informalities:
  - a. At line 4 of claim 2, the word -- of -- should be inserted before “said contact tines”.Appropriate correction is required.
3. Claim 3 is objected to because of the following informalities:
  - a. At line 3, “time” should read -- tine --.
  - b. At line 4, “tine” should read -- tines --.Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2 and 3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claim 2 recites the limitation "each one of said pair of primary members" in lines 2 and 3. Prior recitation within claim 2 only claims one pair of primary members, whereas the above limitation indicates more than one pair of primary members. The claim is unclear, therefore there is insufficient antecedent basis for this limitation in the claim.
6. Claim 3 recites the limitation "each one of said pair of primary members" in lines 2 and 3. Prior recitation within claim 3 only claims one pair of primary members, while the above limitation indicates more than one pair of primary members. The claim as written is unclear. Therefore, there is insufficient antecedent basis for this limitation in the claim.
7. Lines 2 and 3 of claim 3 recite a method having an initial step that appears to define the structure of an apparatus. Defining the structure of an apparatus and a method within one claim would inappropriately claim two statutory types of invention in the same claim. It is unclear what type of invention is claimed by the Applicant therefore, claim 3 has been rejected.

***Claim Rejections - 35 USC § 102***

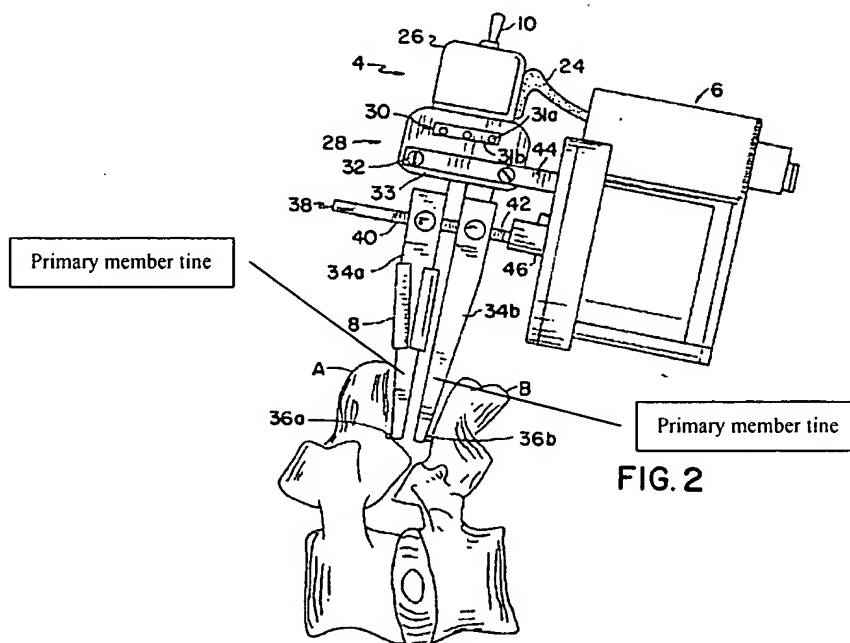
3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Brown et al. (U.S. Patent Number 4,899,761).

In regard to claims 1 and 2, Brown et al. disclose an apparatus (1) that comprises a load measuring means for measuring load between two points and a distance measuring means for measuring distance between said two points (col.3; col.4 lines 1-4). The apparatus (1) further comprises a pair of primary members (34a, 34b) being hingedly fixed together. The primary members of the Brown et al. device have contact tines as shown in Fig. 2 below.



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The apparatus measures the load of the contact tines as well as the distance between the contact tines (col.3; col.4 lines 1-4). The Brown et al. apparatus is adapted to engage a pair of intervertebral bodies to measure a load therein and said a distance therebetween as depicted in Fig. 2.

In regard to claim 3, use of the Brown et al. apparatus consist of a method comprising inserting contact tines of the apparatus between adjacent vertebrae. Once the device is appropriately positioned, the user would measure a load and distance between the adjacent vertebrae of interest.

### ***Double Patenting***

8. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

9. Claims 1, 2, and 3 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1, 6, and 7 of copending Application No. 10/845005. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fangemonique Smith whose telephone number is 571-272-8160. The examiner can normally be reached on Mon - Fri 7am - 3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571-272-4726. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**CHARLES MARMOR**  
**PRIMARY EXAMINER**